



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/412,404	10/05/1999	JOSHUA D. KAPLAN	106.48	9614

7590 04/27/2006

MICHAEL E DERGOSITS
DERGOSITS & NOAH LLP
FOUR EMBARCADERO CENTER
SUITE 1150
SAN FRANCISCO, CA 94111

EXAMINER

FADOK, MARK A

ART UNIT	PAPER NUMBER
----------	--------------

3625

DATE MAILED: 04/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/412,404		KAPLAN, JOSHUA D.	
	Examiner		Art Unit	
	Mark Fadok		3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-38, 52-60 and 67-80 is/are pending in the application.
- 4a) Of the above claim(s) 67-80 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-38 and 52-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>8/8/05, 1/30/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to RCE

The examiner is in receipt of applicant's response to office action mailed 8/16/2005, which was received 1/19/2006, 1/30/2006. Acknowledgement is made that to the addition of claims 67-80, leaving claims 21-38, 52-60 and 67-80 as pending in the instant application. The applicant's arguments have been carefully considered. In regards to the USC 112 rejection, the arguments are persuasive and this rejection has been removed. In regards to the rejection on the merits the applicant's arguments were not persuasive therefore the previous rejection is restated below:

Election/Restrictions

Newly submitted claims 67-80 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: As noted by the applicant the new claims contain the divergent feature of scanning a barcode which is not found in the original claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 67-80 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21,23,24,26,27,28,29,34,38,53,56, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos et al (US 5,734,719), and further in view of eshop (article from applicant's IDS dated 12/28/2001, paper# 13).

In regards to claim 21, Tsevdos discloses a method for enabling a remote user to preview a portion of a pre-recorded video product from a network web site containing pre-selected portions of different pre-recorded video products, using a computer (abstract),

a computer display and a telecommunications link between the remote user's computer and the network web site (Fig 15 and 17), the method comprising the steps of:

a) using a web browser process at the remote user's computer to establish a telecommunications link to the network web site wherein the network web site comprises:

(i) a central host server coupled to a communications network running at least one application program for retrieving and transmitting the pre-selected portion of the pre-recorded video product upon request by a remote user (abstract), and

(ii) a central storage device for storing pre-selected portions of a plurality of different pre-recorded video products (abstract) and

(iii) a database associated with the application program for the persistent storage of user-related information (Fig 1, customer database);

Tsevdos teaches maintaining customer data in a centralized host database (FIG 1), but does not specifically mention that prior to previewing the video products, user identification data is provided to the central computer to track the users progress through the web site. Eshop teaches automatic customer tracking of a customer's website visit to record merchandising information for customized promotions on a next

visit to the web site (page PA00634). It would have been obvious to a person of ordinary skill in the art at the time of the invention to include in Tsevdos tracking of customer usage of the website, because this gathered information produces better targeted promotions which strengthen their customer relations by not providing information that is not of interest to the buyer. ;

c) choosing at least one pre-selected portion of the pre-recorded video products from the central host server (Fig 24);

d) receiving through the web browser process the chosen pre-selected portion of the pre-recorded products at the remote user's computer (Fig 26);

e) interactively previewing the received chosen pre-selected portion of the pre-recorded video product (Fig 26); and

f) persistently storing data corresponding to the remote user's activities in the database on the network web site along with the user identification in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them using the user identification data (eshop page PA00634, see response above).

Tsevdos teaches accessing and transmitting video over a network from remote servers (abstract); but does not specifically mention the use of a web site (or interaction with a web site), a web browser (or web browser process), or a web server. It was old and well known in the art at the time of the invention to use web-based technology when utilizing the Internet. It would have been obvious to one of ordinary skill in the art at the time of the invention to utilize new means of presenting and distributing information as is

found in the notoriously well known means provided by web processing technology, since including known improvements such as web browser technology (first introduced by Mosaic in 1993) "that provides an easy to use interface that lets us click on links to navigate the web, Mosaic made the internet assessable to a broader group." (page 118, para 5, "The Whole internet for windows 95" Published October 1995). Tsevdos would be motivated to implement the web browser technology for the obvious reason of increasing usage and thus revenue of its system.

In regards to claim 23, Tsevdos teaches wherein the central device comprises a plurality of compact disc - read only memory (CD-ROMs), (Fig 11).

In regards to claim 24, Tsevdos teaches wherein the central storage device comprises a RAID array drive (Fig 4 and 5).

In regards to claim 26, Tsevdos discloses a networked central host web server that retrieves and transmits a pre-selected portion of a pre-recorded video product upon request by a remote user using a web browser over a telecommunications link,

the central host web server hosting a website that enables receipt of the video product through the web browser for previews of pre-selected portions of pre-recorded video products on a computer associated with the remote user;

b) a central storage device that stores pre-selected portions of a plurality of different pre-recorded video products,

the central storage device coupled to the central host server;

c) at least one machine executable program of instructions that provides:

an identification (ID) process comprising recognizing user identification data, transmitted from the remote user's computer to the central host server, prior to preview of the pre-selected portion of the pre-recorded video product by the remote user; a tracking process comprising tracking the remote user's progress through the network web-site; and a control process comprising providing interactive control to the remote user over the preview of the pre-selected portion of the pre-recorded video products; and

d) a database associated with the machine executable program of instructions for the persistent storage of data corresponding to the remote use's activities on the network website along with the user identification data in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them (see response to claim 21).

In regards to claim 27, Tsevdos teaches wherein the portions of plurality of different pre-selected pre-recorded video products are identified and called from the central storage device using unique product codes (see response to claim 26).

In regards to claim 228, Tsevdos teaches a machine executable program of instructions that provides a purchasing process comprising receiving from the user to

an order for purchasing at least one video product and recording the order for processing (Fig 28).

In regards to claim 29, Tsevdos teaches a machine executable program of instructions that provides a listing process comprising providing the user with dynamic lists of the pre-selected portions of the plurality of different pre-recorded video products that have been previewed the most (see response to claim 26).

In regards to claim 34, Tsevdos discloses a networked central host web server that retrieves and transmits a pre-selected portion of a pre-recorded video product upon request by a remote user using a web browser over a telecommunications link,

the central host web server hosting a web site that enables receipt of the video product through the web browser preview pre-selected portions of pre-recorded video products on a computer associated with the remote user;

b) a central storage device that stores pre-selected portions of a plurality of different pre-recorded video products, the central storage device coupled to the central host server;

c) at least one machine executable program of instructions that provide provides:

a identification (ID) process comprising recognizing user identification data, transmitted from the remote user's computer to the central host server, prior to preview of the pre-selected portion of the pre-recorded video product by the remote user; a tracking process that comprising tracking the remote user's progress through the network web site; and control process comprising providing interactive control to the remote user over preview of the pre-selected portion of the pre-recorded video product; and a demographic process, associated with the central host server, that comprises collecting demographic information regarding the user; and

(d) a database associated with the machine executable program of instructions for the persistent storage of data corresponding to the remote user's activities on the network web site along with the user identification data in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them (see response to claim 21).

In regards to claim 38, Tsevdos teaches wherein the demographic information is selected from the group of information types consisting of age, sex, income, ethnicity, education level, marital status, hobbies, and occupation (Fig 29).

In regards to claim 53, Tsevdos teaches a step of gathering, from the network web site, customized market research information according to one or more desired

parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video categories, configuration breakdowns, and demographic user profiles (Fig 29-38).

In regards to claim 56, Tsevdos teaches a machine executable program of instructions that provides a customizable market research process comprising gathering from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video categories, configuration breakdowns, and demographic user profiles (Fig 29-38).

In regards to claim 59, Tsevdos teaches g a machine executable program of instructions that provides a customizable market research process comprising gathering, from the network web site, customized market research information according to one or more desired parameters selected from the group consisting of unit sales, time periods, geographic markets, specific video categories, configuration breakdowns, and demographic user profiles (Fig 29-38).

Claims 25 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos in view of eshop, and further in view of Official Notice.

In regards to claim 25, Tsevdos discloses a method for enabling a remote user to preview a portion of a pre-recorded video product from a network web site containing pre-selected portions of different pre-recorded video products, using a computer, a computer display and a telecommunications link between the remote user's computer and the network web site, the method comprising the steps of

a) using a web browser process the remote user's computer to establish a telecommunications link to the network web site wherein the network web site comprises

(i) a central host server coupled to a communications network running at least one application program for retrieving and transmitting the pre-selected portion of the pre-recorded video product upon request by a remote user, and

(ii) a central storage device for storing pre-selected portions of a plurality of different pre-recorded video products and

(iii) a database associated with the application program for the persistent storage of user-related information;

b) prior to previewing a pre-selected portion of a pre-recorded video product, transmitting user identification data from the remote user's computer to the central host server thereby allowing the central host server to identify and track the user's progress through the network web site using the application program database and user identification data,

d) receiving through the web browser process the chosen pre-selected portion of the pre-recorded video products at the remote user's computer;

e) interactively previewing the received chosen pre-selected portion of the pre-recorded video product; and

f) persistently storing data corresponding to the remote user's activities in the database on the network web site along with the user identification in a manner that allows pre-selected portions of pre-recorded video products previewed by a remote user to be associated with the remote user who previewed them using the user identification data (see response to claim 21).

Concerning the product code, product codes such as SKU's are old and well known in the art at the time of the invention and are often used to identify products in inventory. Therefore, it would have been to a person having ordinary skill in the art to include in the combination of Tsevdos and eshop the use of product codes to identify products, because the use of product codes is a notoriously well known and efficient means to identify and keep track of the products available for pre-view on a website.

In regards to claim 30, Tsevdos teaches a machine executable program of instructions that provides a recording process comprising providing the user with a record of previous previews by the user. The combination of Tsevdos and eshop teaches recording customer usage information and product selection and providing customized information based on this data, but neither specifically mentions that there is information provided which states the previous previews by the customer. Providing information from a database collection in any fashion desired by the marketer to provide a more user-friendly web site customer is notoriously well known in the art at the time of

invention. It would have been obvious to a person to include in Tsevdos and eshop the presentation of prior usage, because it is known that information that improves the use of a website by a user by making searching easier will improve the usefulness and encourage the buyer to return to the web site.

Claims 22,31,32,33,35,36,37,52,54,55,57,58 and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsevdos in view of eshop and further in view of Internet Shopping Network, found of applicants IDS dated 12/28/2001 paper #13.

In regards to claims 22,31,32,33,35,36,37,52,54,55,57,58 and 60, Tsevdos and eshop teach gathering and maintaining personalized customer information, but neither specifically mentions that the information gathered is a rating of the video product. ISN teaches users having the option to rate their music and have the information available online for consumers that prefer to browse music that is popular by other listeners. It would have been obvious to a person having ordinary skill in the art to include in Tsevdos/eshop rating of the videos, because it was notoriously well known in the art at the time of the invention that the more specific the information is the more effective it is for the marketer to narrow the presentation of marketed products.

Response to Arguments

In response to applicant's argument that there is no suggestion to combine the references of Tsevdos and eshop, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as is discussed by Tsevdos in col 3, lines 34-54 it is important to provide an economic network of communication network systems which best serves a customer, therefore, in order to best serve the customer and provide the service to retailers that only use a web browser process as is taught by eshop, Tsevdos would be motivated to increase revenue by incorporating the web browser process or any other networking process that should come available that better serves the customers needs. The examiner has further considered applicant's submitted articles highlighting the fears and concerns of the time, but does not find them convincing since consumers have historically been resistant to change.

Conclusion

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(571) 272-6755**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **receptionist** whose telephone number is **(571) 272-3600**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(571) 273-8300 [Official communications; including

After Final communications labeled

"Box AF"]

(571) 273-6755 [Informal/Draft communications, labeled

"PROPOSED" or "DRAFT"]

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a long horizontal flourish extending to the right.

Mark Fadok

Primary Examiner